

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shell S. Simpson, Ward S. Foster, and Kris R. Livingston

Serial No.: 10/081,484

Examiner: Jungwon Chang

Filed: 02/20/2002

Group Art Unit: 2154

Confirmation No: 1490

Title: System for providing information regarding network resources

APPEAL BRIEF

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1, 3-10, 12-15, 17, 18 and 24-29 are pending. Claims 2, 11, 16, and 19-23 have been canceled. The rejection of Claims 1, 3-10, 12-15, 17, 18 and 24-29 is appealed.

4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

The following is provided pursuant to Rule 41.37(c)(1)(v) which requires "a **concise explanation** of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawings if any, by reference characters." (emphasis added) Accordingly, no attempt has been made in this Summary to identify or explain each and every element of the independent claims or to reference those parts of the Specification and drawings that support each claim element, except that means plus function is identified and the structure, material, or acts described in the Specification as corresponding to each claimed function is set forth with reference to the Specification and the drawings. Nothing in this "concise explanation" should be construed to limit the scope of any of the claims, which are enumerated in full in Appendix I to this Appeal Brief.

Independent Claim 1. In the system of Claim 1, a plurality of unique Web resources can make use of a common interface to access a network user's personal repository. See, for example, Fig. 2B and the accompanying text in the Specification at page 4, lines 10-29.

Independent Claim 7 (including means plus function elements). The Web Server computer of Claim 7 includes an API (application program interface) through which a plurality of Web resources can access a user's personal repository. See, for example, Fig. 2B and the accompanying text in the Specification at page 4, lines 10-29.

The Web Server computer of Claim 7 includes:

means for receiving a request from a client computer over a network (e.g., web server 504 in Fig. 5; web server 1104 in Fig. 11; Specification page 8, lines 3-5), where the client computer is operated by a user having a personal repository for storing job documents and the client computer includes an API for accessing the personal repository (see, e.g., client computer 204 and user's repository 206 in Fig. 2B and Specification page 4, lines 22-29; client computer 302 and content interface 338 in web browser 332 in Fig. 3; Specification page 5, lines 13-15 and page 7, lines 3-9); and

means for responding to the request by sending the client computer a portal Web page (e.g., web server 504 in Fig. 5; web server 1104 and portal web page 1116 in Fig.

11; steps 1212 and 1214 in Fig. 12; Specification page 8, lines 3-5 and page 15, lines 5-28); and

wherein the portal Web page includes a plurality of hyperlinks to a plurality of different Web sites, each Web site providing a Web resource configured to communicate with the API in order to access the user's personal repository (e.g., portal web page 1116 in Fig. 14 and Specification page 16, lines 7-11).

Dependent Claim 9 (including a means plus function element). Claim 9 depending from Claim 7 (Claim 9 is argued separately below) recites the further element of a means for enabling a client computer to search a database that includes information regarding Web Sites available over the network each of which provides a resource configured to communicate with the API (client may access databases 1106 and 1108 through web server 1102 and control system 1102 on web portal site 108 in Fig. 11; Specification page 13, line 27 through page 14, line 2.

Independent Claim 15. The method of Claim 15 includes a server computer responding to a request from a client computer by transmitting a portal Web page to the client. See, for example, steps 1212 and 1214 in Fig. 12 and the accompanying text in the Specification at page 15, lines 5-28. The portal Web page includes information regarding a plurality of different Web resources that are available over the network, each of the Web resources being configured to make use of the same interface in order to access the personal repository when the user is actively making use of the resource. See, for example, portal web page 1116 in Fig. 11, Specification page 15, lines 5-28; and Fig. 2B and the accompanying text in the Specification at page 4, lines 10-29.

Independent Claim 24. The method of Claim 24 includes providing a client computer that includes a Web browser having a Web extension that provides an API for accessing the user's personal repository (e.g., Specification page 4, lines 27-29) and displaying a portal Web page on the client computer that includes a plurality of hyperlinks, each pointing to Web content that is specifically configured to communicate with the API in order to access the user's personal repository (e.g., step 1306 in Fig. 13 and Specification page 15, lines 5-6; portal web page 1116 in Fig. 14 and Specification page 16, lines 7-11)).

Independent Claim 25. The method of Claim 25 includes providing a client computer including an API for accessing the user's personal repository (e.g., client computer 204 in Fig. 2B and the accompanying text in the Specification at page 4, lines 10-29) and displaying a portal Web page on the client computer that includes a plurality of hyperlinks, each pointing to a Web resource that is configured to communicate with the API in order to access the user personal repository (e.g., step 1306 in Fig. 13 and Specification page 15, lines 5-6; portal web page 1116 in Fig. 14 and Specification page 16, lines 7-11).

6. GROUNDS OF REJECTION TO BE REVIEWED.

1. Claims 1, 5 and 6 stand rejected under Section 103 as being obvious over the combination of Wood (6453127) and Wang (20030009537).
2. Claims 7, 8, 13-15, 17 and 24-29 stand rejected under Section 103 as being obvious over the combination of Wood (6453127), Wang (20030009537) and Nagal (7143109).
3. Claims 3 and 4 were rejected under Section 103 as being obvious over the combination of Wood (6453127), Wang (20030009537) and Gopalan (20030076526).
4. Claims 9, 10, 12 and 18 were rejected under Section 103 as being obvious over the combination of Wood (6453127), Wang (20030009537), Nagal (7143109) and Gopalan (20030076526).

7. ARGUMENT.

GROUND NO. 1

Claims 1, 5 and 6 stand rejected under Section 103 as being obvious over the combination of Wood (6453127) and Wang (20030009537).

A. Plural Resources Accessing A Repository Through A Common Interface.

The system of Claim 1 includes:

- a Web client computer coupled to a network and operable by a user having a personal repository for storing job documents;
- an interface for accessing the user's personal repository; and

a Web site coupled to the network and operable to cause the client to display a portal Web page that includes a plurality of hyperlinks each pointing to a unique Web resource that is available over the network, wherein each of the Web resources can make use of the same interface in order to access the user's personal repository.

Thus, in the system of Claim 1 each of a plurality of web resources on the portal page can make use of the same interface to access the user's personal repository.

In evaluating the question of obviousness, the Examiner must determine the scope and content of the prior art and then ascertain the differences between the claimed subject matter and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. MPEP 2142.

The Examiner asserts that Wood teaches each of a plurality of web resources on the portal page using the same interface to access a user's personal repository, as recited in Claim 1:

"wherein each of the web resources make use of the same interface (touch screen) in order to access a user's personal repository (col. 3, lines 11-65, user interface display page for the printer 15... reprint operation gives user the ability to select document files from storage and print hard copy')." Final Action page 3.

* * *

"Wood discloses wherein each of the web resources configured to make use of the same interface in order to access the personal repository when the user is actively making use of the resource (col. 3, lines 11-65, user interface display page for the printer 15... reprint operation gives user the ability to select document files from storage and print hard copy"; col. 5, line 62 - col. 6, line 34; col. 6, lines 41-54)." Final Action page 7.

For the reasons detailed below, the Examiner's assertion is not correct. That is to say, the Examiner has not properly determined the scope and content of the prior art. Accordingly, the Examiner has not ascertained the true differences between the claimed subject matter and the prior art -- his legal finding of obviousness is based upon a false factual premise. It necessarily follows, therefore, that the Examiner has failed to carry his burden of establishing a prima facie case of obviousness.

In Wood, the printers 15, 15' and 15" (i.e., the plural web resources) do not access print job document job storage (e.g., file server memory 39) through the user interface display page. On the contrary, the user interface display page, delivered as a web page, gives the user access to a printer 15, 15' or 15" configuration through an ordinary web browser so no special software is needed on each user computer. This display is all about the user 11, 11' or 11" accessing a printer 15, 15' or 15" and nothing about a printer 15, 15' or 15" accessing a repository of print job documents. The "reprint" function on the user interface display page is wholly irrelevant to how the plural printers 15, 15' and 15" access print job document storage, whether for printing or reprinting.

The only thing that Wood teaches about printers 15, 15' and 15" accessing print job document storage (e.g., a user repository) is that each printer accesses its own respective file server memory 39. Wood column 2, lines 58-60 and column 4, lines 41-45. Wood does not teach each printer 15, 15' and 15" accessing the same repository through a common interface.

B. Wood's Marking Systems Supervisors Are Not the Claimed Interface.

The Examiner asserts in item (1) on page 9 of the Final Action that Wood's marking systems supervisors 23 in Fig. 2 meet the claimed interface limitations. This assertion is not correct. Each printer 15, 15' and 15" in Wood includes a marking systems supervisor 23 -- Fig. 2 illustrates an exemplary printer typical of printers 15, 15' and 15" in Fig. 1. Wood column 4, lines 19-23. Wood does not teach or even suggest that each printer 15, 15' and 15" has access to a memory 37, 39 through any or all of the other printer's marking systems supervisor 23. On the contrary, Wood teaches only that each printer 15, 15' and 15" accesses a memory 37, 39 through its own marking systems supervisor 23 (to the extent it is correct even to say memory 37, 39 is accessed through a marking systems supervisor 23). Hence, Wood does not teach multiple printers accessing the same repository (or even different repositories) through the same interface.

C. The Distinguishing Features Are Recited In Claim 1.

The Examiner also asserts, incorrectly, that the "features upon which applicant relies (i.e., accessing the **same** repository through a **common** interface) are not recited in the rejected claim(s)." Final Action page 9 (emphasis in original).

Claim 1 recites that each of the Web resources can make use of the same interface in order to access the user's personal repository. "The" user's personal repository recited in this element of Claim 1 refers back to the earlier recitation of "a user having a personal repository." Although "a user" means one or more users and "a personal repository" means one or more personal repositories, the subsequent reference to **the** user's personal repository is still referring to the **same** repository whether that repository is a single repository or plural repositories possessed by a single user or plural users.

The "same" interface recited in this element of Claim 1 refers back to the earlier recitation of "an interface for accessing the user's personal repository." Although "an interface" means one or more interfaces, the subsequent reference to the **same** interface is still referring to an interface that is common to all of the Web resources whether that interface is a single interface or plural interfaces.

The Examiner's assertion to the contrary in item (1) at page 9 of the Final Action is not correct.

D. It Would Not Have Been Obvious To Combine Wood And Wang.

The Examiner argues it would have been obvious to combine Wood with Wang because Wang's portal web page "would allow the user to select a particular device of interest by clicking on the representation of the device", citing to Wang page 8, paragraph 0104. Of course, this is the primary advantage of any Web based portal page -- to allow the user to select one of the links to a web site or other resource displayed on the page. Appellants fail to see how this generalized benefit might somehow be deemed to suggest or motivate using a portal Web page with the printer schema of Wood, in which the user/client transmits documents to the printer via the Internet through a file server. Indeed, it is not at all apparent how a portal Web page could or should be used in Wood, particularly if one ignores (as one must) the Appellants disclosure.

The question of obviousness under Section 103 is not whether each of the differences between the claimed invention and the prior art would themselves have been obvious, but whether the claimed invention as a whole would have been obvious. MPEP § 2141.02(I) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) and *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)). Even if it is assumed (for purposes of argument only but not conceding) that Wood and Wang individually teach all of the elements of Claim 1, there is no reason the ordinarily skilled artisan would combine those elements in the manner of Claim 1. That is to say, the invention of Claim 1 as a whole would not have been obvious.

The Supreme Court recognized in *KSR* that it is important to identify a reason the ordinarily skilled artisan would combine elements from the prior art in the manner claimed:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. ___, 127 S. Ct. 1727 (April 30, 2007) (pages 15-16 of the Bench Opinion).

This holding from *KSR* is reiterated in the Office's Examination Guidelines for Determining Obviousness in View of...*KSR* as follows:

When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” Federal Register vol. 72, no. 195 October 10, 2007 p. 57527.

The generalized notion that a Web based portal page allows a user to select links displayed on the page is an insufficient reason to suggest using a portal Web page with the unrelated printer schema of Wood (in which the user/client transmits documents to

the printer via the Internet through a file server). No showing has been made that the core elements recited in Claim 1 as a whole would have been obvious based on the disparate elements of Wood and Wang.

For all of these reasons, Appellants respectfully submit that Claim 1 distinguishes patentably over the combination of Wood and Wang. Claims 5 and 6 also distinguish over Wood and Wang due to their dependence on Claim 1. The rejection of Claims 1, 5 and 6, therefore, should be reversed.

GROUND NO. 2

Claims 7, 8, 13-15, 17 and 24-29 stand rejected under Section 103 as being obvious over the combination of Wood, Wang and Nagal (7143109).

A. Plural Resources Accessing A Repository Through A Common Interface.

The rejection of Claims 7, 8, 13-15, 17 and 24-29 is based on the assertion that Wood teaches each of a plurality of web resources on the portal page using the same interface to access a user's personal repository, as claimed. As detailed above for Claim 1, this assertion is not correct.

Claim 7 recites a Web Server that includes:

means for receiving a request from a client computer over a network, where the client computer is operated by a user having a personal repository for storing job documents and the client computer includes an API for accessing the personal repository; and

means for responding to the request by sending the client computer a portal Web page;

wherein the portal Web page includes a plurality of hyperlinks to a plurality of different Web sites, each Web site providing a Web resource configured to communicate with the API in order to access the user's personal repository.

Thus, in the web server of Claim 7, like the system of Claim 1, each of a plurality of web resources on the portal page can make use of the same interface (an API in Claim 7) to access the user's personal repository. Claims 15, 24 and 25 recite similar limitations.

Therefore, for the reasons detailed above for Claim 7, the rejection of Claims 7, 15, 24 and 25 and dependent Claims 8, 13-14, 17, and 26-29 should be reversed.

B. Advertising Web Resources That Can Use The Common Interface.

Claim 5, depending from Claim 1, recites the further limitation that the Web page includes an advertisement of a Web resource that can make use of the interface to access the user's personal repository. Claims 8, 13 and 17 recite similar limitations.

The Examiner argues such limitations are inherent in Wood -- "web page has an inherent functionality that includes advertising hyperlink or banner (fig. 4; col. 2, lines 11-17; col. 3, line 49 - col. 4, line 7)." Final Action page 4.

Even if it is assumed that the inherent functionality in a web page includes the ability to advertise a web resource, such functionality does not render obvious any and all uses of that functionality. The plain fact is that Wood does not teach or even suggest advertising any web resource on any web page, specifically not advertising a printer that can make use of a common interface to access a document server. And, such advertising is not necessary to the functionality in Wood. In fact, Wood's failure to disclose the claimed common interface makes it totally irrelevant to the further limitations of Claims 5, 8, 13 and 17.

For this additional reason, the rejection of Claims 5, 8, 13 and 17 should be reversed.

GROUND NO. 3

Claims 3 and 4 were rejected under Section 103 as being obvious over the combination of Wood, Wang and Gopalan (20030076526).

A. Claims 3 And 4 Depend From Claim 1.

Claims 3 and 4 depend from Claim 1. Therefore, for the reasons detailed above for Claim 1, Claims 3 and 4 also distinguish patentably over the cited references.

B. Browsable Database Of Web Resources.

Claim 3, depending from Claim 1, recites that the web site includes a browsable database of information regarding web resources that are available over the network and that can make use of the interface in order to access the user's personal repository. Claim 4, depending from Claim 1, recites that the web site includes a browsable database of information regarding devices each respectively represented by a web resource available over the network that can make use of the interface in order to access the user's personal repository.

The Examiner cites Gopalan (20030076526) as teaching the browsable database limitations added in these dependent claims. In so doing, however, the Examiner has ignored the content of the claimed database -- a database of web resources that can use the common interface to access the user's personal repository. Nowhere does the Examiner address the content of the claimed database. The database 416 in Gopalan is a database of print jobs, not a database of printers. In the context of the claimed subject matter, the Gopalan database represents a user repository of print job documents, not printers that can access the repository of print job documents. Hence, Gopalan does not teach the further limitations of Claims 3 and 4.

GROUND NO. 4

Claims 9, 10, 12 and 18 were rejected under Section 103 as being obvious over the combination of Wood, Wang, Nagal and Gopalan (20030076526).

A. Claims 9-10, 12 and 18 Depend From Claims 7 and 15, Respectively.

Claims 9, 10 and 12 depend from Claim 7. Claim 18 depends from Claim 15. Therefore, for the reasons detailed above for Claims 7 and 15, Claims 9, 10, 12 and 18 also distinguish patentably over the cited references.

B. Browsable Database Of Web Resources.

Claim 9, depending from Claim 7, recites that the web server computer includes a database having information regarding Web Sites available over the network each providing a resource configured to communicate with the API and a means for enabling a client computer to search the database. Claim 18, depending from Claim 15, recites

that the method includes: providing a database associated with the server, the database including information regarding available Web Resources that are configured to make use of the interface in order to access a user's personal repository of job documents; the server computer receiving a query of the database from a client; and the server computer responding to the query by searching the database and sending the results of the query to the client.

The Examiner cites Gopalan (20030076526) as teaching the database limitations added in these dependent claims. In so doing, however, the Examiner has ignored the content of the claimed database -- a database of web resources that can use the common interface to access the user's personal repository. Nowhere does the Examiner address the content of the claimed database. The database 416 in Gopalan is a database of print jobs, not a database of printers. In the context of the claimed subject matter, the Gopalan database represents a user repository of print job documents, not printers that can access the repository of print job documents. Hence, Gopalan does not teach the further limitations of Claims 9 and 18 (and Claims 10 and 12 depending from Claim 9).

Respectfully submitted,

/Steven R. Ormiston/

Steven R. Ormiston
Attorney for Appellants
Reg. No. 35,974

APPENDIX I -- CLAIMS INVOLVED IN THE APPEAL

1. A system, comprising:
 - a Web client computer coupled to a network and operable by a user having a personal repository for storing job documents;
 - an interface for accessing the user's personal repository; and
 - a Web site coupled to the network and operable to cause the client to display a portal Web page that includes a plurality of hyperlinks each pointing to a unique Web resource that is available over the network; and wherein each of the Web resources can make use of the same interface in order to access the user's personal repository.
2. (canceled)
3. The system of claim 1, wherein the Web site includes a browsable database of information regarding Web Resources that are available over the network and that can make use of the interface in order to access the user's personal repository.
4. The system of claim 1, wherein the Web site includes a browsable database of information regarding devices each respectively represented by a Web resource available over the network that can make use of the interface in order to access the user's personal repository.
5. The system of claim 1, wherein the Web page includes an advertisement of a Web resource that can make use of the interface to access the user's personal repository.
6. The system of claim 1, wherein the Web site generates the Web page based, at least in part, upon a job document stored in the user's personal repository.

7. A Web Server computer, comprising:
means for receiving a request from a client computer over a network, where the client computer is operated by a user having a personal repository for storing job documents and the client computer includes an API for accessing the personal repository; and
means for responding to the request by sending the client computer a portal Web page; and
wherein the portal Web page includes a plurality of hyperlinks to a plurality of different Web sites, each Web site providing a Web resource configured to communicate with the API in order to access the user's personal repository.

8. The Web server computer of claim 7, wherein the Web page includes an advertisement of a particular Web resource configured to communicate with the API in order to access the user's personal repository.

9. The Web Server computer of claim 7, further comprising:
a database including information regarding Web Sites available over the network each providing a resource configured to communicate with the API; and
means for enabling a client computer to search the database.

10. The Web server computer of claim 9, wherein the database further includes information regarding devices that are represented by at least some of the Web resources.

11. (canceled)

12. The Web Server computer of claim 9, further comprising:
means for dynamically discovering Web Sites connected to the network that provide a Web resource configured to communicate with the API; and
means for adding information regarding the dynamically discovered Web Sites to the database.

13. The Web Server computer of claim 7, wherein the Web page includes an advertisement regarding a Web resource configured to access the user's personal repository through the API.

14. The Web server computer of claim 7, further comprising:
means for generating the Web page based upon a characteristic of a job document stored in the user's personal repository.

15. A method, comprising:
providing a server computer in communication with a network;
the server computer receiving a request from a client computer over the network, where the client computer is operable by a user that has a personal repository for storing the user's job documents;
the server computer responding to the request by transmitting a portal Web page to the client, the Web page including information regarding a plurality of different Web resources that are available over the network; and wherein each of the Web resources configured to make use of the same interface in order to access the personal repository when the user is actively making use of the resource.

16. canceled

17. The method of claim 15, wherein the Web page further includes an advertisement of a service provided by a resource configured to access the personal repository through the interface.

18. The method of claim 15, further comprising:
providing a database associated with the server, the database including information regarding available Web Resources that are configured to make use of the interface in order to access a user's personal repository of job documents;
the server computer receiving a query of the database from a client; and

the server computer responding to the query by searching the database and sending the results of the query to the client.

19-23. (canceled)

24. A method, comprising:

providing a client computer operable by a user having a personal repository for storing job documents, where the client computer includes a Web browser having a Web extension, the Web Extension providing an API for accessing the personal repository; and

displaying a portal Web page on the client computer that includes a plurality of hyperlinks, each pointing to Web content that is specifically configured to communicate with the API in order to access the user's personal repository.

25. A method, comprising:

providing a client computer operable by a user having a personal repository for storing job documents and including an API for accessing the user's personal repository;

displaying a portal Web page on the client computer that includes a plurality of hyperlinks, each pointing to a Web resource that is configured to communicate with the API in order to access the user personal repository.

26. The system of claim 1, wherein the interface resides on the Web client computer.

27. The system of claim 26, wherein the interface comprises an API.

28. The method of claim 15, wherein the interface resides on the client computer.

29. The method of claim 28, wherein the interface comprises an API.

APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

none

APPENDIX III -- RELATED PROCEEDINGS

none